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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,068	08/30/2006	Gunter Fuhr	P-9039-US	5979
49443	7590	02/15/2011	EXAMINER	
Pearl Cohen Zedek Latzer, LLP			KIM, TAEYOON	
1500 Broadway				
12th Floor			ART UNIT	PAPER NUMBER
New York, NY 10036			1651	
			NOTIFICATION DATE	DELIVERY MODE
			02/15/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@pczlaw.com  
Arch-USPTO@pczlaw.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/591,068	FUHR, GUNTER	
	<b>Examiner</b>	<b>Art Unit</b>	
	Taeyoon Kim	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 December 2010.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 52-102 is/are pending in the application.

4a) Of the above claim(s) 52-96 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 97-102 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

Applicant's amendment and response filed on 12/21/2010 has been received and entered into the case.

Claims 1-51 are canceled, claims 52-96 have been withdrawn from consideration as being drawn to non-elected subject matter, and claims 97-102 have been considered on the merits. All arguments have been fully considered.

### **Response to Amendment**

The declaration under 37 CFR 1.132 filed 12/21/2010 is insufficient to overcome the rejection of claims 97-102 based upon Pelrine as set forth in the last Office action.

The declaration discussed differences between the claimed invention as amended and the Pelrine's levitating microparticle device. The declaration alleged that the current invention requires the carrier having a bottom element capable of being placed and shifted in a mechanically stable manner whereas Pelrine discloses the carrier being levitated. However, the declaration failed to show any evidence that the levitating particle device of Pelrine is unstable or how significantly different the Pelrine's device from the claimed invention in terms of "stability".

In the absence of any standard given in the specification to determine the term "mechanically stable manner", and without clear evidence how the claimed invention being "placed and shifted in a mechanically stable manner" is significantly stable over levitation taught by Pelrine, it is the Examiner's position that the levitating particle device of Pelrine is also mechanically stable. In addition, the instant claims do not particularly exclude levitation. Rather the claims are directed to exerting a magnetic force to move the cell carrier. Thus, the levitation

taught by Pelrine cannot be excluded from the scope of the claimed invention. Still further, Pelrine teaches that the stable or stabilized movement on X-Y plane (horizontal movement) as well as Z-axis (vertical movement) of the microparticles (par. 138), and also the biasing element to hold and move the microparticles (see Fig. 12 and par. 140). Thus, the levitating microparticle device of Pelrine is considered “mechanically stable”.

Thus, it is considered that the movement or shifting of the carrier of the current invention is carried out via the same magnetic force, and the levitational movement as well as the horizontal movement via the biasing element of Pelrine is considered mechanically stable.

The declaration discussed that the term “stability” and the carrier being displaced “on”, rather than from, the base surface, and the oriented movement takes place on the surface and not above it. It appears that the declaration intends to point out that the cell carrier’s bottom element is in contact with the base surface rather than it is floating or levitating above the base. However, the instant claims do not disclose such limitation requiring the contact between the bottom element and the base surface.

Furthermore, the limitation of “placed and shifted on a solid surface in a mechanically stable manner” is disclosed as a property of the bottom element, but it does not require any active step. The instant claims are construed as the steps of positioning the biological cell on a cell carrier having a bottom element, and moving the cell carrier via a magnetic force. The instant claims are structured such that the limitation is a mere possibility (i.e. “... such that it **CAN** be placed and shifted...”), rather than a requirement for the claimed method.

Based on the above discussion, it is concluded that the declaration as well as applicant's argument, which is mainly the same argument as the declaration, is not persuasive to overcome the pending claim rejection.

#### **Claim Rejections - 35 USC § 112 – New Rejection**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 97-102 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly amended limitation of "mechanically stable manner" does not clearly point out what subject matter the phrase intends to point out. The term "stable" is a relative term. It is vague what would be considered as "mechanically stable manner" in the absence of any definition given in the specification. The term "mechanically stable" in claim 97 is a relative term which renders the claim indefinite. The term "stable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 97-102 are rejected under 35 U.S.C. 102(b) as being anticipated by Pelrine et al. (US 2002/0106314) for the reason set forth in the previous OA mailed on 8/27/2010.

Applicant's response to the previous OA is based on the new limitation of "mechanically stable manner", and it appears that applicant alleges the levitating particle device of Pelrine is not "mechanically stable manner". The argument is substantially the same as those in the declaration discussed above, and the Examiner would not repeat the same rebuttal as above.

As discussed above, the Examiner wishes to emphasize that there is no disclosure in the current claims that the scope of the instant invention exclude levitation as a result of exerting a magnetic force. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the bottom element being in contact with the surface of the base/solid) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In addition, it appears that the physical contact between the bottom element of the cell carrier and the surface of the base/solid is critical to distinguish the instant invention from the teaching of Pelrine, and applicant is recommended to amend the claims to disclose this particular limitation in the claims.

### **Conclusion**

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taeyoon Kim whose telephone number is (571)272-9041. The examiner can normally be reached on 8:00 am - 5:00 pm ET (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taeyoon Kim/  
Primary Examiner, Art Unit 1651